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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,372	12/01/2000	Hans-Rudolf Nageli	ATM-2273	5299

7590 05/21/2004

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EXAMINER

TSOY, ELENA

ART UNIT PAPER NUMBER

1762

DATE MAILED: 05/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/726,372

Applicant(s)

NAGELI ET AL.

Examiner

Elena Tsoy

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 May 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 28-55.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

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Advisory Action

1. The Arguments filed on May 13, 2004 under 37 CFR 1.116 in reply to the final rejection have been entered and considered but are not deemed to place the application in condition for allowance because claims 28-54 stand rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention; and the specification also stands objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.

Response to Arguments

2. Applicant's arguments filed May 13, 2004 have been fully considered but they are not persuasive.

(A) Applicants argue that the Examiner has merely quoted the added material and asserted that it is a new matter. The Examiner has not even set out any reason or explanation of why the added material is new matter, or any facts to support her assertion of new matter.

The Examiner asserted that the added material, i.e. "the temperature at the surface of the plastic coating and the adhesion-promotion agent lying **below** the crystallite melt point (Tk) of the plastic", is a new matter because the Examiner simply could not find the added material in the specification as filed. For these reasons, the Examiner stated that the added material is not *supported by the original disclosure*, and, therefore, is a new matter.

If Applicants think that the added material is supported by the original disclosure, Applicants have to show that "the temperature at the surface of the plastic coating and the

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adhesion-promotion agent lying **below** the crystallite melt point (Tk) of the plastic” is supported not by scientific/technical principles and the knowledge of one skilled in the art, but by the specification as filed.

(B) Applicants argue that section 2163.07 of MPEP states “The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter”.

However, “the temperature at the surface of the plastic coating and the adhesion-promotion agent lying **below** the crystallite melt point (Tk) of the plastic” is **not a definition**.

(C) Applicants argue that Examples 11 and 12 of Heyes et al use the Heyes et al method including “preheating the metal strips”. Accordingly, Examples 11 and 12 of Heyes et al do not anticipate any of applicants’ process claims.

The Examiner respectfully disagrees with this argument. Examples 11 and 12 of Heyes et al do anticipate applicants’ process of claim 28 because the method of claim 28 “**comprises**” recited steps. Accordingly, the method does not exclude the step of “preheating the metal strips”.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elena Tsoy whose telephone number is (571) 272-1429. The examiner can normally be reached on Mo-Thur. 9:00-7:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Shrive Beck can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read 'ETsoy'.

Elena Tsoy
Primary Examiner
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May 18, 2004